UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,658	01/23/2001	Jeremy A. Kenyon	41018.P009	3790

25943	7590	09/28/2005	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C.			NGUYEN BA, HOANG VU A	
PACWEST CENTER, SUITE 1900			ART UNIT	PAPER NUMBER
1211 SW FIFTH AVENUE			2192	
PORTLAND, OR 97204				

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/768,658	KENYON ET AL.
	Examiner	Art Unit	
	Hoang-Vu A. Nguyen-Ba	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 July 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/6/05 & 7/5/05</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1. This action is responsive to amendment filed July 5, 2005.

2. Claims 1-24 remain pending.

Information Disclosure Statement

3. The Office acknowledges receipt of the Information Disclosure Statements filed June 6, 2005 and July 5, 2005. They have been placed in the application file and the information referred to therein has been considered.

Response to Argument

4. Applicant's arguments filed concurrently with the above-mentioned amendment have been fully considered but are not persuasive. The following is an examiner's response to Applicant's arguments.

    a. In response to Applicant's assertion that Moshir, art of record, is not qualified as prior art reference because the invention of the instant application was reduced to practice on July 18, 2000 predating the priority date, i.e., September 22, 2000, of Moshir, the examiner respectfully notes that Applicant's assertion is not sufficiently persuasive. Since the time interval between the date that Applicant's invention was reduced to practice and the filing date of Moshir's provisional application is only **two months and four days**, this time interval is considered not long enough to effectively disqualify Moshir as prior art reference because Moshir could equally submit affidavit asserting that his invention was conceived and reduced to practice before Applicant's date of July 18, 2000.

b.   Even assuming, for the sake of argument, that Moshir is not available as prior art for the reasons discussed previously, the examiner asserts that the features claimed in instant claims are not specifically described in the document entitled "Update Service v1.5 Feature List," submitted as corroborating evidence in support of Applicant's affidavit to disqualify Moshir as prior art reference.

Specifically, the feature "check in … to determine if the client's computer's software needs to be updated" is nowhere found to be explicitly described in the document. Instead, the closest feature to the above limitation in the "New Features in v1.5" is found at page 3, in ¶ "Backwards compatibility with previous WildTangent® Updater versions" (e.g., "[e]ven if an older version of the Updater client is detected checking in, it is handled by being instructed to update itself to the new version"). As best understood by the examiner, this feature does not appear to be similar to the claimed "check in … to determine if the client's computer's software needs to be updated." To determine if the client's computer's software (note that first, the client's computer's software include more software components than merely the Updater and second, these additional software components are nowhere mentioned in this document) needs to be updated implies that there is such an option that if there is **no** need for updating then the update will not be effected (e.g., the client may decide that the Updater and other application software components do not need to be updated and that current versions of these software components can be effectively maintained). The mentioned new feature in v1.5 appears to be a mandatory update of the Updater notwithstanding the client's decision of reusing the current version of the Updater and/or the other application software components.

Moreover, the feature of "providing the client computer with an update task list listing one or more tasks to be performed by the client" is nowhere found described in the document. Instead, the closest feature is found in ¶ "Distributed application check-[i]n and file download server capability" at page 3 of the document as "... application check-in and file download servers can be specified separate from the Update Service Check-In servers. As well, multiple check-in and download servers can be specified and if one is busy or unresponsive, another in the list will be tried." This feature may provide support for the claimed "... asynchronously at a later point or later points in time to update..." but does provide no support whatsoever for an update task list listing one or more tasks to be performed by the client computer, let alone support for the limitation "providing the client computer with an update task list."

In view of the foregoing discussion, the examiner maintains that the rejection of Claims 1-24 under 35 U.S.C. § 102(e) as being anticipated by Moshir is proper.

The rejection of these claims is reproduced below for Applicant's convenience.

Claim Rejections – 35 U.S.C. § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

6.   Claims 1-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0100036 A1 by Moshir et al. ("Moshir").

Claim 1

Moshir discloses at least:

accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated (see at least paragraph [0104]); and

providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software is to be updated (see at least [0055], [0059], [0104], [0195]).

Claim 8

Since claim 8 recites the same limitations of claim 1, the same rejection is therefore applied. Moshir further discloses *performing said one or more tasks asynchronously at a later point or later points in time to update the client computer's software* (see at least [0061-0062]).

Claim 13

Since claim 13 recites an apparatus comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claim 20

Since claim 20 recites a client computer comprising a storage medium that stores programming instructions executed by a processor to perform the same method steps recited in claim 1, the same rejection is therefore applied.

Claims 2 and 14

The rejection of base claims 1 and 13, respectively is incorporated. Moshir further discloses *determining if the client computer's software needs to be updated* (see at least section "Discovery Agent," e.g., [0089-0101]).

Claims 3, 9, 15 and 21

The rejection of the base claim is incorporated. Moshir further discloses *re-contacting the server at a later point or later points in times to retrieve one or more software parts* (see at least [0061-0062]).

Claims 4, 10, 16 and 22

The rejection of the base claim is incorporated. Moshir further discloses *re-contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts* (see at least [0058], [0060-0061]).

Claims 5, 11, 17 and 23

The rejection of the base claim is incorporated. Moshir further discloses *one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts* (see at least [0061-0062]).

Claims 6 and 18

The rejection of the base claim is incorporated. Moshir further discloses *servicing one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in the task list* (see at least [0059], [0195-0236]).

Claims 7 and 19

The rejection of the base claim is incorporated. Moshir further discloses *asking the client computer to retry one or more of the subsequent asynchronous requests for software parts* (see at least Figure 3A, item 312 and related discussion in the specification).

Claims 12 and 24

The rejection of the base claim is incorporated. Moshir further discloses *scheduling asynchronous performance of said tasks* (see at least [0061-0062]).

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu "Antony" Nguyen-Ba whose telephone number is (571) 272-3701. The Examiner can normally be reached on Tuesday-Friday, 7:15 to 17:45.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam can be reached at (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ANTONY NGUYEN-BA
PRIMARY EXAMINER

Art Unit 2192

September 17, 2005